



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/900,220	07/24/97	MIAO	ONV044.01

PATENT GROUP  
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HM22/0329

EXAMINER
WILSON, M

ART UNIT	PAPER NUMBER
1633	11

DATE MAILED: 03/29/99

Please find below and/or attached an Office communication concerning this application or  
proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/900,220**

Applicant(s)  
**Miao et al.**

Examiner  
**Wilson, Michael C.**

Group Art Unit  
**1633**



☒ Responsive to communication(s) filed on Dec 30, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-48 is/are pending in the application.

Of the above, claim(s) 28-48 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-27 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1633

### **DETAILED ACTION**

Applicants election of Group I filed 12-30-98, Paper No. 10, has been entered. Upon reconsideration and the request of applicants, the species election has been rewritten to include the patentably distinct species of small organic molecules which was not an option in the previous restriction requirement.

Claims 1-48 are pending in the instant application. Claims 1-27 are under consideration in the instant application.

#### ***Election/Restriction***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- 1) Antisense (claims 13-15),
- 2) a small organic molecule (claim 16),
- 3) Protein Kinase A inhibitor (claims 17-21),
- 4) Nucleic acid SEQ ID NO:7 or 8 (claims 36 and 44), or
- 5) Polypeptide SEQ ID NO: 16 or 17 (claims 30 and 35).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Antisense, small organic molecules, protein kinase A inhibitors, nucleic acid SEQ ID NO:7 and 8 and polypeptide SEQ ID NO: 16 and 17 differ from one another in structure, function and

Art Unit: 1633

mode of action. Therefore, the groups have different issues regarding patentability and enablement and represent patentably distinct subject matter.

Currently, claims 1-12 and 22-27 are generic. If applicants elect species 1, the generic claims will be considered with claims directed toward antisense only as they relate to antisense (claims 1-15 and 22-27). If applicants elect species 2, the generic claims will be considered with claims directed toward small organic molecules only as they relate to small organic molecules (claims 1-12, 16 and 22-27) wherein said small organic molecules are different than antisense, protein kinase A inhibitors, SEQ ID NO:7, 8, 16 or 17. If applicants elect species 3, the generic claims will be considered with claims directed toward protein kinase inhibitors only as they relate to protein kinase inhibitors (claims 1-12, 17-27). If applicants elect species 4, the generic claims will be considered as they relate to SEQ ID NO:7 or 8 (claims 1-12 and 22-27). If applicants elect species 5, the generic claims will be considered as they relate to SEQ ID NO:16 or 17 (claims 1-12 and 22-27).

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

Art Unit: 1633

of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson whose telephone number is (703) 305-0120.

*Deborah Crouch*

DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1800/1630

mcw

March 25, 1999